

REMARKS

In an Office Action mailed on September 5, 2002, an objection was made to the title; claims 3-12 were rejected under 35 U.S.C. § 112, second paragraph; claim 12 was rejected under 35 U.S.C. § 112, first paragraph; claims 1-3 and 9-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lesthievent; claims 1-5 and 9-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyake; claims 1-5 and 9-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamanaka; claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable of Yamanaka and further in view of either Machida, Brown, Lunner or Nillesen; and claim 8 was objected to as being dependent upon a rejected base claim but allowable if rewritten in independent form. The title has been amended to overcome the objection to the title. Claim 12 has been canceled for purposes of expediting prosecution. It is noted that the infinite impulse response filter of claim 12 and other different types of filters are covered by the broader language of claim 1. The § 112, second paragraph rejections and the § 103(a) rejections are addressed in the corresponding sections below.

A marked-up version of the amended claims is submitted as a separate document. The undersigned has endeavored to ensure that the clean and marked-up versions of the amended claims correspond. However, the Examiner is specifically requested to verify that these two versions of the claims are consistent.

§ 112, Second Paragraph Rejections of Claims 3-11:

Claims 5-7 and 11 have been amended to overcome the § 112, second paragraph rejections of these claims. Regarding the § 112, second paragraph rejections of claims 3, 4 and 8-10, these claims do not reference a processing circuit(s) other than a reference to the processing circuit on line 1 of claim 1. Thus, it is submitted that as originally filed, claims 3, 4 and 8-10 overcome the § 112, second paragraph rejections.

Rejections of Claims 1-7 and 9-11:

The Examiner rejects claim 1 under 35 U.S.C. § 103(a) in view of either Lesthievent, Miyake or Yamanaka. However, the Examiner fails to establish a *prima facie* case of obviousness for claim 1 for at least the reason that none of these references teach or suggest a tap selection circuit.

In the Office Action, the Examiner states that in Lesthievent, "the switches s(i) are capable of providing the equivalent function," states that in Miyake, "'output selecting circuits (7)' are capable of providing the equivalent function," and states that in Yamanaka, "the 'selecting circuits 12(i)' are capable of providing the equivalent function." Office Action, pp. 3-5. However, the Examiner fails to provide a suggestion or motivation to modify either one of these references to derive the missing claim limitation, i.e., the tap selection circuit. The mere fact that references *can* be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. M.P.E.P. § 2143.01; *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

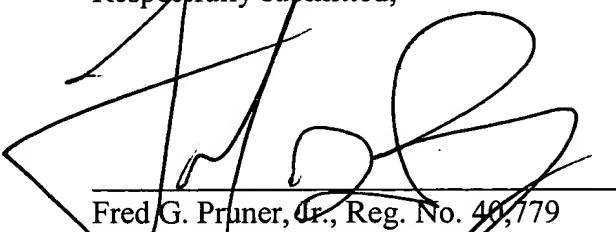
Thus, a *prima facie* case of obviousness has not been established for claim 1. Claims 2-11 are patentable for at least the reason that these claims depend from an allowable claim.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 112 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to pay any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0277US).

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Respectfully submitted,


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